

1 IN THE UNITED STATES DISTRICT COURT

2 EASTERN DISTRICT OF MISSOURI

3 EASTERN DIVISION

4 -----x

5 MONSANTO COMPANY and :

6 MONSANTO TECHNOLOGY LLC, :

7 Plaintiffs, :

8 vs. : Case No.

9 E.I. DUPONT DE NEMOURS AND : 4:09-cv-00686-ERW

10 COMPANY and PIONEER HI-BRED :

11 INTERNATIONAL, INC., :

12 Defendants. :

13 -----x

14  
15 August 26, 2010

16 9:09 a.m.

17  
18 Videotaped Deposition of STEVEN E.

19 JACOBSEN, Ph.D., held at the offices of

20 WINSTON & STRAWN LLP, 200 Park Avenue, New York,

21 New York, before Frank J. Bas, a Registered

22 Professional Reporter and Notary Public of the

23 State of New York.

24  
25 JOB NO.: 24-184353

1 A. That meets which definition?

2 Q. The clause that says signal a --  
3 "actually functions to signal a cellular enzyme  
4 to associate with the DNA and to initiate"  
5 cellular -- "the cellular process (transcription  
6 into mRNA using one of the DNA strands as a  
7 template) of making a corresponding,  
8 complementary strand of RNA."

9 A. Okay. And so then what's the  
10 question again?

11 Q. My question is, if there's  
12 transcription, if you see transcription of a DNA  
13 sequence, does that mean there is a promoter in  
14 the DNA that meets that clause that I just read?  
15 That definition you have provided.

16 MR. SUH: Objection, lacks  
17 foundation.

18 A. I believe that the vast majority of  
19 the time that would be yes.

20 Q. Okay. Let's turn back to the  
21 patent. In particular, Column 7 at the bottom.  
22 Approximately Line 60, the patent states,  
23 "Promoters which are known or found to cause  
24 transcription of DNA in plant cells can be used  
25 in the present invention."

1 Do you see that?

2 A. Yes.

3 Q. And then there's a reference to  
4 certain promoters, the CaMV35A promoter.

5 Do you see that?

6 A. Yes.

7 Q. And an FMV35S promoter.

8 Do you see that?

9 A. Yes.

10 Q. And they also talk about promoters  
11 isolated from plant genes, such as ssRUBISCO  
12 genes. Do you see that?

13 A. I see those words.

14 Q. And the maize ubiquitin promoter.

15 Do you see that?

16 A. Yes.

17 Q. And there is also a reference to a  
18 rice actin promoter. Correct?

19 A. Yes.

20 Q. In your opinion, are all these  
21 promoters intended to be covered in the phrase  
22 "promoter which functions in plant cells"?

23 A. Question again, please?

24 Q. Are all of these promoters that  
25 we've identified at the bottom of Column 7 in

1 your judgment intended to be included within the  
2 claim term that says "promoter which functions  
3 in plant cells"?

4 A. I would say so. They're all  
5 promoters which function in plant cells.

6 Q. Does the CaMV --

7 MR. HILMERT: Strike that.

8 BY MR. HILMERT:

9 Q. The CaMV35A promoter that's listed  
10 refers to the cauliflower mosaic virus promoter.

11 Is that right?

12 A. Actually, it's a mistake. It should  
13 be the CaMV35S promoter.

14 Q. And you understand that the CaMV35A  
15 refers to -- it should be 35S. Right?

16 A. I think that's a typo.

17 Q. Does that refer to the cauliflower  
18 mosaic virus?

19 A. I believe so.

20 Q. Does the cauliflower mosaic virus  
21 35S promoter initiate transcription in all plant  
22 cells?

23 MR. SUH: Objection, vague.

24 A. I don't believe so.

25 Q. Can you think of an example plant

1 cell that the cauliflower mosaic virus 35S

2 promoter does not initiate transcription in?

3 A. No.

4 Q. Does the FMV35S promoter initiate

5 transcription in all plant cells?

6 MR. SUH: The same objection.

7 A. I don't know.

8 Q. Can you think of one, or do you have

9 evidence of a plant cell that the FMV35S

10 promoter does not work in?

11 A. I don't know.

12 Q. What about the ssRUBISCO promoter;

13 does that work in all plant cells?

14 MR. SUH: The same objection.

15 A. I doubt it.

16 Q. Does the maize ubiquitin promoter

17 work in all plant cells?

18 A. Possibly, but I'm not sure.

19 Q. What about the rice actin promoter;

20 does that work in all plant cells?

21 A. Possibly, but I'm not sure.

22 Q. Are you aware of any promoter that a

23 person of ordinary skill in the art in the '90

24 to '94 time frame would expect to work in all

25 plant cells?

1 A. No.

2 Q. Do you believe that the phrase  
3 "promoter which functions in plant cells" that  
4 appears in Claim 103 requires that the promoter  
5 function in all plant cells?

6 A. Claim 103 (Pause.) That's Part A?

7 Q. Yes.

8 A. And the question, please?

9 Q. Do you believe that the phrase  
10 "promoter which functions in plant cells" that  
11 appears in Claim 103 requires that the promoter  
12 function in all plant cells?

13 A. You mean that a single promoter  
14 would function in every single plant cell?

15 Q. Right.

16 A. No.

17 Q. That's not what that means?

18 A. No.

19 Q. I want to turn your attention back  
20 to your expert report, Paragraph 149. Two lines  
21 from the bottom of Page 39 in Paragraph 149,  
22 there's a reference to "the promoter is designed  
23 and constructed to actually cause the EPSPS  
24 enzyme, defined by the structural DNA sequence,  
25 to be produced by a plant cell in a large enough